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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/572,751

10/04/2006

Roger Picano

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7055 7590 12/10/2009  
GREENBLUM & BERNSTEIN, P.L.C.  
1950 ROLAND CLARKE PLACE  
RESTON, VA 20191

EXAMINER

BROWN, COURTNEY A

ART UNIT

PAPER NUMBER

1616

NOTIFICATION DATE

DELIVERY MODE

12/10/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com  
pto@gbpatent.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/572,751	<b>Applicant(s)</b> PICANO ET AL.	
	<b>Examiner</b> COURTNEY BROWN	<b>Art Unit</b> 1616	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/22/08 and 8/17/09</u> .                                     | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Acknowledgement of Receipt/Status of Claims***

This Office Action is in response to the amendment filed August 17, 2009. Claims 12-31 are pending in the application. Claims 1-11 were cancelled in a preliminary amendment filed October 4, 2006. Claims 12-13 are newly added in a preliminary amendment filed October 4, 2006. Claims 12-31 are being examined for patentability.

Applicant's arguments, see pages 2-7, filed August 17, 2009, with respect to the rejection(s) of claim(s) 12-31 under 35 USC 103 (a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection has been made below.

Rejections not reiterated from the previous Office Action are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set of rejections and/or objections presently being applied to the instant application.

### ***Withdrawn Rejections***

The rejection of claims 12-31 under 35 U.S.C. 103(a) over Yasuda et al. (JP 330560) and Albacarys et al. (US Patent 6,338,855 B1) in view of Golz-Berner et al. (US Patent 6,989,150 B1) has been withdrawn.

***Information Disclosure Statement***

The Information Disclosure Statements (IDS) submitted on January 22, 2008 and August 17, 2009 have been considered by the examiner.

***Claim Objections***

Claims **21, 23 and 24** are objected to because of the following informalities:

There are words written in all capitol letters in the claims which is improper. Appropriate correction is required.

***New Rejection(s)***

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 12-21 and 26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yasuda et al. (JP 330560, previously cited in the Office Action mailed on April 16, 2009) in view of Golz-Berner et al. (US Patent 6,989,150 B1, previously cited in the Office Action mailed on April 16, 2009).**

***Applicant's Invention***

Applicant claims a cosmetic preparation comprising (a) a protein hydrolyzate from at least one of silk, pashmina, cashmere wool, merino wool and mohair, (b) an extract from mussel threads of mussels, (c) at least one of sericin and a hydrolyzate of sericin, and (d) optionally, one or more amino acids which are at least one of biogenic and functional.

***Determination of the scope and the content of the prior art  
(MPEP 2141.01)***

Yasuda et al. teach a hair dye composition containing (A) 0.001-20 (esp. **0.01-5**) wt.% of protein hydrolyzate(s) such as **keratin** protein hydrolyzate(s), **collagen** protein hydrolyzate(s), **silk** protein hydrolyzate(s) **or elastin** protein hydrolyzate(s) and (B) 0.001-20 (esp. 0.01-5)wt.% of **amino acid**(s) (derivative(s)) such as glycine, (phenyl)alanine, valine, leucine, serine, threonine, tyrosine, asparagine (aspartic acid), cysteine, histidine, arginine, glutamine, pyrrolidonecarboxylic acid and salt(s) thereof (abstract, claims 12, 15-17, 21, 22-24, 28-31 of instant application).

***Ascertainment of the difference between the prior art and the claims  
(MPEP 2141.02)***

The difference between the invention of the instant application and that of Yasuda et al. is that Yasuda et al. do not expressly teach the use of an extract from mussel threads of mussels and at least one antioxidant in an amount of 0.1 to 10% of the composition. This deficiency in Yasuda et al. is cured by Golz-Berner et al. Golz-Berner et al. teach a cosmetic preparation comprising extracts of byssus (mussel silk) (see claim 8 of Golz-Berner et al.) and an extract of the silkworm obtained by extraction, containing a vitamin mix in a range from 0.1 to 10 percent by weight (column 2, lines 8-10).

The difference between the invention of the instant application and that of Yasuda et al. is that Yasuda et al. do not expressly teach the use of taurine, carnitine, creatine or glutathione.

***Finding of prima facie obviousness***

***Rationale and Motivation (MPEP 2142-2143)***

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of the Yasuda et al. and Golz-Berner et al. to arrive at a cosmetic preparation for the hair comprising an extract from mussel threads of mussels. One would have been motivated to make this combination in order to receive the expected benefit of having a composition that as a source of a biotechnological protein (see claim 8 of Golz-Berner et al.) In addition, both Yasuda et al. and Golz-Berner et al. teach cosmetic compositions as instantly claimed. Thus, in view of *In re Kerkhoven*, 205 USPQ 1069 (C.C.P.A. 1980), it is *prima facie* obvious to combine two or more compositions each of which is taught by prior art to be useful for the same purpose in order to form a third composition that is to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in prior art, thus claims that requires no more than mixing together two cosmetic compositions set forth *prima facie* obvious subject matter.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of the Yasuda et al. to arrive at a cosmetic preparation for the hair comprising taurine. It is known that taurine is an amino acid. Yasuda et al. teach the use of amino acids selected from glycine, (phenyl)alanine, valine, leucine, serine, threonine, tyrosine, asparagine (aspartic acid), cysteine, histidine, arginine and glutamine. Thus, absent a showing of unexpected results, the instant claims would have been obvious because the substitution of one known amino

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for another would have yield predictable result to one of ordinary skill in the art at the time of the invention.

In light of the forgoing discussion, the Examiner concludes that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a).

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

**Claims 12-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Astrid et al. (DE 10333253, machine translation attached) in view of Golz-Berner et al. (US Patent 6,989,150 B1, previously cited in the Office Action mailed on April 16, 2009).**

### ***Applicant's Invention***

Applicant claims a cosmetic preparation, specifically a **shampoo**, comprising (a) a protein hydrolyzate from at least one of silk, pashmina, cashmere wool, merino wool and mohair, (b) an extract from mussel threads of mussels, (c) at least one of sericin and a hydrolyzate of sericin, and (d) optionally, one or more amino acids which are at least one of biogenic and functional.

***Determination of the scope and the content of the prior art  
(MPEP 2141.01)***

Astrid et al. teach cosmetic formulations contain a complex (A) of (A1) sericin, sericin hydrolyzate, their derivatives and/or mixtures and (A2) fibroin (a type of protein created by Bombyx mori (silkworms) in the production of silk) its hydrolyzate, their derivatives and/or mixtures (abstract). Astrid et al. teach that (A1) in the active substance complex (A) is selected from :

1. **Sericin**,
2. **hydrolyzed** and/or other **derivatized Sericin**, as for example commercial products with the INCI - designations Sericin, Hydrolyzed Sericin, or **Hydrolyzed Silk**,
3. mixture from **amino acids** serine, aspartate and glycine and/or their methyl, Propyl, ISO Propyl, Butyl, ISO butyl ester, whose salts as for example hydrochlorides, sulfates, acetates, citrates, tartrates, whereby in this mixture the serine and/or its derivatives are contained to 20 to 60 % of the composition , the aspartate and/or its derivatives to 10-40 % of the composition and the glycine and/or its derivatives to 5 to 30,% of the composition ([0021]).
4. mixtures of 1-3.

Astrid et al. teach that (A2) in the active substance complex (A) is selected from:

1. hydrolyzed and/or other derivatized fibroin, particularly part-hydrolyzed Fibroin, which contains the **amino acid** sequence Ser Gly Ala Gly Ala Gly as major constituent,
2. the amino acid sequence Ser Gly Ala Gly Ala Gly,
3. mixture of amino acids glycine, alanine and tyrosine and/or their methyl, Propyl, ISO Propyl, Butyl, ISO butyl ester, whose salts as for example hydrochlorides, sulfates,

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acetates, citrates, tartrates, whereby in this mixture the glycine and/or its derivatives are contained in amounts of 20-60 % of the composition and the alanine and its derivatives in amounts of 10-40 % by weight of the composition and the tyrosine and its derivatives in amounts from 0 to 25% by weight of the composition, or

4. mixtures of 1-3 ([0024-0025]).

Astrid et al. teach that the active substance complex (A) is **0.001-10** % of the cosmetic composition ([0026]) and that the two active ingredients (A1) and (a2) are used in the ratio from 10:90 to 70:30, in particular 15:85 to 50:50 and whole 20:80 to 40:60 ([0023]). Astrid et al. also teach the use of **ascorbic acid** (antioxidant of instant application) and **collagen** as additives([0105]). Astrid et al. teaches that the aforementioned agents/components contain the active ingredients preferred in a suitable aqueous, alcoholic or aqueous-alcoholic carriers for example creams, emulsions, gels or also foaming solutions, such as **shampoos**, foam aerosols or other preparing, which are suitable for the application on the hair ([0118]).

***Ascertainment of the difference between the prior art and the claims  
(MPEP 2141.02)***

The difference between the invention of the instant application and that of Yasuda et al. is that Yasuda et al. do not expressly teach the use of an extract from mussel threads of mussels and at least one antioxidant in an amount of 0.1 to 10% of the composition. This deficiency in Yasuda et al. is cured by Golz-Berner et al. Golz-Berner et al. teach a cosmetic preparation comprising extracts of byssus (mussel silk) (see claim 8 of Golz-Berner et al.) and an extract of the silkworm obtained by

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extraction, containing a vitamin mix in a range from 0.1 to 10 percent by weight (column 2, lines 8-10).

***Finding of prima facie obviousness***

***Rationale and Motivation (MPEP 2142-2143)***

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of the Yasuda et al. and Golz-Berner et al. to arrive at a cosmetic preparation for the hair comprising an extract from mussel threads of mussels. One would have been motivated to make this combination in order to receive the expected benefit of having a composition that as a source of a biotechnological protein (see claim 8 of Golz-Berner et al.) In addition, both Yasuda et al. and Golz-Berner et al. teach cosmetic compositions as instantly claimed. Thus, in view of *In re Kerkhoven*, 205 USPQ 1069 (C.C.P.A. 1980), it is *prima facie* obvious to combine two or more compositions each of which is taught by prior art to be useful for the same purpose in order to form a third composition that is to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in prior art, thus claims that requires no more than mixing together two cosmetic compositions set forth *prima facie* obvious subject matter.

In light of the forgoing discussion, the Examiner concludes that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a).

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From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

### ***Response to Arguments***

Applicant's arguments, filed January 26, 2009 with respect to the 103 rejection of claims 12-31 under 35 U.S.C. 103(a) as being unpatentable over Yasuda et al. (JP 330560) and Albacarys et al. in view of European Cosmetic Markets (The Magic of Molluscs, February 2004) have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The claims remain rejected.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR Only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electron Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Courtney Brown, whose telephone number is 571-270-3284. The examiner can normally be reached on Monday-Friday from 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Courtney A. Brown  
Patent Examiner  
Technology Center 1600  
Group Art Unit 1616

*/Mina Haghighatian/*  
Primary Examiner, Art Unit 1616